



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/635,994

08/09/2000

Howard Dernehl

DERN-00101

5407

28960 7590 11/18/2009
HAVERSTOCK & OWENS LLP
162 N WOLFE ROAD
SUNNYVALE, CA 94086

EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

11/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/635,994	DERNEHL ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,12,13,15-23,27-30,34-36,40,41 and 43-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,6-10,12,13,15-23,27-30,34-36,40,41 and 43-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/3/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 11/9/2009.
2. Claims 1-4, 4, 6-10, 12-13, 15-23, 27-30, 34-36, 40-41 and 43-51 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1-4, 6-10, 13, 15-21, 23, 27-30, 34-36, 40-41 and 43-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over article titled "Argos Business Solutions: Customer Referral Scheme Encourages Sales of Mobile Phones" Argos Business Solutions over article titled, "recommend-it.com"

With respect to claims 1-4, 7-10, 12-13, 15-16, 19, 27, 40-41, 46-51 Argos Business Solutions teaches a method of marketing (entire document). providing a referral-based service and one or more marketable entities to be purchased, wherein the referral-based service and the one or more marketable services are provided by a Service Provider and any purchase transaction of one of the one or more marketable entities is performed by the Service Provider (i.e. existing customers refer colleagues, friends or family to purchase a new mobile phone and the existing customers receive points)(page 1, paragraph 3); offering a reward to the first party by the Service Provider in response to the first

Art Unit: 3688

party purchasing the marketable entity, the reward is in exchange for a recommendation that results in a purchase of the marketable entity by a second party (i.e. existing customers collect points for purchases made by the referee (page 1, paragraph 3);

correlating data within a database, the data within the database comprising data relating to the reward offered to the first party and providing the reward to the first party if the second party purchases the marketable entity (i.e. database of quality branded items such as sports goods, children's toys and garden equipment are provided to the existing customers for purchases made by the referee)(page 2, paragraph 1); the recommendation being selected from a group consisting of goods and services (i.e. various purchases by the referee qualifies the existing customer to receive points)(page 1, paragraph 3).

Argos doesn't specifically teach personalizing the referral of the marketable entity (i.e. mobile phone) including a serial number for the marketable entity (i.e. mobile phone). Official Notice is taken that serial numbers are unique letters and numbers that are used for identification of a product, hardware or software. It would have been obvious to a person of ordinary skill in the art at the time of have included in Argos personalizing the referral by providing to the referee the serial number of the marketable entity (mobile phone) in order to uniquely and unequivocally identify the marketable entity (i.e. mobile phone).

Argos Business Solutions doesn't specifically teach sending the recommendation via an e-mail message to the second party including an URL link to the web site of the

Art Unit: 3688

service provider and updating the database with the e-mail address of the second party. Recommend-it.com teaches the first user will send an e-mail to a friend or colleague detailing the site and would include a short description identifying advertisements)(page 2); correlating the first set of data in the first e-mail message to data within a database (page 2); updating the database with an e-mail address of a second party provided by the first party (pages 1-4); forwarding the first e-mail message to the e-mail address of the second party (see page 4). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the invention of Argos Business Solutions the teachings of recommend-it.com of sending the recommendation via an e-mail message to the second party comprising a personalized referral for the marketable entity including an URL link to the web site of the service provider and updating the database with the e-mail address of the second party because such a modification would allow the second party the convenience of using his or her computer to viewed all the details of the items recommended.

Claims 6, 17-18, 20, further recite that the link is accessible through a token in the form of a first icon visible in the message. Official notice is taken that it is old and well known in the computer related field to have a token in the form of an icon that is visible in the message in order to represent a function, object or program. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a token in the form of a first icon visible in the message in order to make file navigations and manipulation easier.

Claims 23, 28-30, 34-36, 43-45 further recite crediting an account within a database and recording the reward credited. Official notice is taken that it is old and well known in the business related arts to credit an account because such a modification would provide an easy and efficient way to reward a customer. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included crediting an account within a database and recording the reward credited in order to obtain the above mentioned advantage.

Response to Arguments

5. Applicant's arguments filed 11/9/2009 have been fully considered but they are not persuasive.

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that in Argos there is absolutely no details of using any electronic means whatsoever for implementing the incentive scheme. The Examiner wants to point out that although Argos is silent as to the implementation of the incentive scheme but given Recommend-it reference which teaches computer implementation of an incentive scheme it would have been obvious **at the time of Applicant's invention** to have combined the references to use electronic means to implement the Argos incentive scheme.

Art Unit: 3688

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one skilled in the art given the Argos reference would be able to combine it with Recommend-it to provide the electronic means of implementing the incentive scheme using electronic means in order to provide accessibility and convenient to the incentive scheme of Argos. The reasoning to combine the reference need not only be found in the reference but can also be from knowledge generally available to one of ordinary skill in the art so as is in this case (see case laws above). In addition Argos teaches a database of merchandises and points (paragraph 3) so therefore Argos is not totally silent as to the use of electronic means.

8. With respect to Applicant's arguments pertaining to the first set of data comprising a first serial number having an offer to transact an exchange for the marketable entity, the arguments are moot see new rationale above.

9. With respect to correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data related to the reward offer to the first party. The Examiner wants to point that although Argos is silent to the electronic means for transmitting the referral to the second party, Argos nevertheless

Art Unit: 3688

teaches the first party referring the second party, the referral correlating or relating the referral to discounts, merchandises, points are store in a special database that the first users will get for the referral (paragraph 3). The recommendation of the second party is related to the incentives, points, merchandises that the first party will receive for the recommendation.

10. With respect to Applicant's arguments pertaining to updating the database with an e-mail address of the second party. The Examiner wants to point out that in Recommend-it service constructs a personalized e-mail message to the second party that was recommended by the first party in order for Recommend-it to send the message to the second party, the e-mail addresses must be stored somewhere in order to enable Recommend-it to retrieve and use of the e-mail address provided. Just because Recommend-it doesn't sell or transfer e-mail addresses to third parties, it doesn't mean that they don't store the e-mail addressed in their databases.

11. Applicant argues that Recommend-it doesn't teach a from filed populated with an e-mail address of the first party, The Examiner disagrees with Applicant because in Recommend-it, the e-mail received by the second party includes the e-mail address of the recommender. For example, Eileen_velet@didem.com represents the starting point or where the recommendation came from.

12. With respect to claim 4, Applicant further argues that the references do not teach updating the database with e-mail addresses of a third party provided by the first or second party. The Examiner disagrees with Applicant because as stated above, in Recommend-it the first party can recommend or send messages to up to 3 different e-

Art Unit: 3688

mail addressed, the second person that the first recommends will be considered the third party in the claims and Recommend-it would have to store the e-mail addresses of all parties recommended in order to later construct the personalized messages.

13. With respect to claims 8-9, Applicant argues that the references do not teach authenticating e-mail messages. The Examiner wants to point out that in Recommend-it the first user provides the e-mail messages of the referees to Recommend-it which will forward an e-mail messages to the second parties , third parties on behalf of the first party, the e-mail addressed would have to be the e-mail addresses would have to authenticated by the system in order for the e-mail to be sent for example, at the point where Recommend-it construct the e-mail messages to the second, third parties, the e-mail addresses correctness is confirmed in order for the e-mail to be transmitted. If an incorrect e-mail was submitted for a particular party then the party will not be able to receive the message because of the incorrect e-mail address.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Weinhardt can be reached on (571)272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3688

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
11/17/2009